

Combined Declaration and Power of Attorney for Patent Application

Docket Number: 1581.0250001/DRSC/ALF

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter that is claimed and for which a patent is sought on the invention entitled Cathode Arc Source and Graphite Target, the specification of which is attached hereto unless the following box is checked:

- ☒ was filed on January 25, 1999;
as United States Application Number 09/236,113; and
was amended on _____ (if applicable).

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I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information that is material to patentability as defined in 37 C.F.R. § 1.56.

I hereby claim foreign priority benefits under 35 U.S.C. § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT international application, which designated at least one country other than the United States listed below, and have also identified below any foreign application for patent or inventor's certificate, or PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s)

Priority Claimed

GB 9615548.6
(Application No.)

Great Britain
(Country)

24 July 1996
(Day/Month/Year Filed)

☒ Yes ☐ No

(Application No.)

(Country)

(Day/Month/Year Filed)

☐ Yes ☐ No

I hereby claim the benefit under 35 U.S.C. § 119(e) of any United States provisional application(s) listed below.

(Application No.)

(Filing Date)

(Application No.)

(Filing Date)

I hereby claim the benefit under 35 U.S.C. § 120 of any United States application(s), or under § 365(c) of any PCT international application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT international application in the manner provided by the first paragraph of 35 U.S.C. § 112, I acknowledge the duty to disclose information that is material to patentability as defined in 37 C.F.R. § 1.56 that became available between the filing date of the prior application and the national or PCT international filing date of this application.

PCT/GB97/01992
(Application No.)

24 July 1997
(Filing Date)

Published
(Status - patented, pending, abandoned)

To Be Assigned
(U.S. National Phase of
PCT/GB97/01992)
(Application No.)

25 January 1999
(Filing Date)

Abandoned
(Status - patented, pending, abandoned)

I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

Robert G. Sterne, Esq., Reg. No. 28,912; Edward J. Kessler, Esq., Reg. No. 25,688; Jorge A. Goldstein, Esq., Reg. No. 29,021; Samuel L. Fox, Esq., Reg. No. 30,353; David K.S. Cornwell, Esq., Reg. No. 31,944; Robert W. Esmond, Esq., Reg. No. 32,893; Tracy-Gene G. Durkin, Esq., Reg. No. 32,831; Michele A. Cimbala, Esq., Reg. No. 33,851; Michael B. Ray, Esq., Reg. No. 33,997; Robert E. Sokohl, Esq., Reg. No. 36,013; Eric K. Steffe, Esq., Reg. No. 36,688; Michael Q. Lee, Esq., Reg. No. 35,239; and Steven R. Ludwig, Reg. No. 36,203.

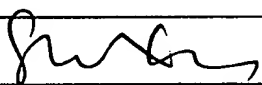

Send Correspondence to:

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005-3934

Direct Telephone Calls to:

(202) 371-2600

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of sole or first inventor Xu SHI	
Signature of sole or first inventor	 20/05/99 Date
Residence BLK 356, #02-402, Woodlands Avenue 5, Singapore 730356	
Citizenship Singapore	
Post Office Address same as above	
Full name of second inventor Beng Kang TAY	
Signature of second inventor	 20/05/99 Date
Residence 18 Sin Ming Walk #06-01, Singapore 575569	
Citizenship Singapore	
Post Office Address same as above	

Full name of third inventor Hong Siang TAN	
Signature of third inventor <i>Tan Hong Siang</i>	Date 20 May 1999
Residence 24 Jalan 17/1, 46400 Petaling Jaya, Selangor, Singapore	
Citizenship Singapore	
Post Office Address same as above	
Full name of fourth inventor David Ian FLYNN	
Signature of fourth inventor	Date
Residence 7 Welland Close, Crowborough, East Sussex TN6 3BF	
Citizenship British	
Post Office Address same as above	

PHUSERSATERR YALF1581025-1/declaration
REGD Form 1/1999

(Supply similar information and signature for subsequent joint inventors, if any)



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OFFICE OF PETITIONS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Shi *et al.*

Appl. No.: 09/236,113

Filed: January 25, 1999

For: **Cathode Arc Source and Graphite
Target**

Art Unit: 1753

Examiner: *To Be Assigned*

Atty Docket: 1581.0250001

Declaration of George W. Schlich Under M.P.E.P. § 409.03(d)

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

I, George W. Schlich, Chartered Patent Attorney at Mathys & Squire, 100 Gray's Inn Road, London WC1X 8AL, England, do hereby declare as follows:

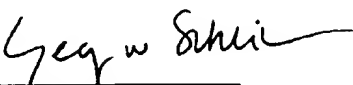
1. I received a copy of the Notice to File Missing Parts of Application - Filing Date Granted issued by the U.S. Patent and Trademark Office in the above-referenced application. On May 6, 1999 Mathys & Squire forwarded a copy of the Combined Declaration and Power of Attorney for Patent Application and Assignment documents ("the documents") to Mr. Flynn. [See Exhibit A]
2. On May 11, 1999, Mr. Flynn was telephoned regarding the documents. Mr. Flynn informed Mathys & Squire that he had not received the documents. On May 12, 1999, the documents were again sent to Mr. Flynn via registered mail. [See Exhibit B] Mr. Flynn telephoned Mathys & Squire on May 13, 1999, informing Mathys & Squire that he was refusing to sign the documents until his inventorship contribution and potential compensation had been settled. In particular, Mr. Flynn expressed disappointment over

being the fourth named inventor on the patent application, rather than the first named inventor. On May 14, 1999, Mr. Flynn's refusal to cooperate was reported to Professor Yeong Hin Yuen at Filplas Vacuum Technology PTE Ltd., the entity to which the above-referenced application is to be assigned. [See Exhibit C]

3. Throughout July, 1999 Mathys & Squire attempted to contact Mr. Flynn regarding the documents, without success. On July 28, 1999, Dr. Xu Shi informed Mathys & Squire that discussion had taken place between Mr. Flynn and the Nanyang Technological Institute ("the Institute"). The Institute employed Mr. Flynn and the other named inventors at the time of the invention of the above-referenced application. Dr. Shi requested that another set of the documents be sent to Mr. Flynn. [See Exhibit D]
4. On July 30, 1999, Mathys & Squire unsuccessfully attempted to contact Mr. Flynn via telephone. On August 4, 1999, the documents were once again sent to Mr. Flynn via registered mail. [See Exhibit E] Mathys & Squire unsuccessfully attempted to contact Mr. Flynn on a weekly basis throughout August, 1999.
5. On September 6, 1999, Mathys & Squire spoke with Mr. Flynn via telephone. Mr. Flynn advised that he was still unwilling to sign any forms.

All statements made herein of my own knowledge are true. All statements made on information and belief are believed to be true. The statements are made with the knowledge that willful false statements and the like so made are punishable by fine, imprisonment, or both, under 18 U.S.C. 1001 and may jeopardize the validity of the above-referenced U.S. application or any patent issuing therefrom.

Executed on this 9th day of September, 1999, in London, England.



George W. Schlich

F:\WPDOCS\GWS\NEWEMAIL\025DECLS.WPD

SKGF 1/28/98 dcw

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Shi *et al.*

Appl. No.: 09/236,113

Filed: January 25, 1999

For: **Cathode Arc Source and Graphite Target**



Art Unit: 1753

Examiner: *To Be Assigned*

Atty Docket: 1581.0250001

Declaration of Xu Shi Under M.P.E.P. § 409.03(d)

Assistant Commissioner for Patents
Washington, DC 20231

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Sir:

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I, Xu Shi, do hereby declare as follows:

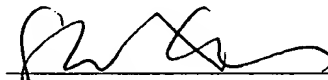
1. I am the first named inventor of the above-referenced application entitled Cathode Arc Source and Graphite Target.
2. David Flynn is also a named inventor for the above-referenced application and contributed to the claimed invention through his joint efforts with me and other inventors.
3. Mr. Flynn, the other named inventors, and I were employed by the Nanyang Technological Institute ("the Institute") at the time of the invention of the above-referenced application. Mr. Flynn's employment contract with the institute, attached as Exhibit A hereto, to provide that Mr. Flynn inform the Institute of any invention and enter into a mutual arrangement to enable the Institute to obtain a patent to such an invention. [see Exhibit A, ¶13.] Filplas Vacuum Technology PTE Ltd., the entity to

which the above-referenced application is to be assigned, is a private company set up by the Insitute to exploit intellectual property derived from the Institute.

4. I was informed that Mr. Flynn refused to sign the Combined Declaration and Power of Attorney for Patent Application and Assignment documents in the above-referenced application. I spoke with Mr. Flynn in July, 1999 and he was concerned about possible compensation for his efforts. I explained to him that any compensation to inventors will be given by the Institute according to rules and regulations established by the Institute. I also informed Mr. Flynn that he will receive his fair share of any compensation given to the inventors of the above-referenced application.

All statements made herein of my own knowledge are true. All statements made on information and belief are believed to be true. The statements are made with the knowledge that willful false statements and the like so made are punishable by fine, imprisonment, or both, under 18 U.S.C. 1001 and may jeopardize the validity of the above-referenced U.S. application or any patent issuing therefrom.

Executed on this 9th day of September, 1999, in Singapore Singapore


Xu Shi, Ph.D.



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Our Ref: GWS/19296 US
Yr. Ref: -

David Flynn Esq
7 Welland Close
Crowborough
East Sussex TN6 3BF

6 May 1999

Dear David,

New US Patent Application
"Reversing Field"
In the name of Shi *et al*

You will recall you are named as an inventor on a number of patent applications filed in the name of Nanyang Technological University. The application covering the "Reversing Field" invention has recently been filed as a patent application in the USA. Each of the inventors is initially named as applicant in the USA and are required as a matter of formality to execute (i) a Declaration and (ii) an Assignment in respect of the US patent application.

I am enclosing both documents and would be grateful if you could sign and date them where indicated. Please can you also put your initials next to the place where I have corrected your citizenship from Singapore to United Kingdom.

Also enclosed is a stamped envelope for return of these forms and I look forward to receiving them from you. If you have any questions about the forms then I would ask you to call me on 0171 830 0000.

Lastly, we are currently required to file these forms in the USA before 12 May 1999 and if it is possible for you to sign and return the forms within the next few days then this would be most appreciated.

Yours sincerely

George W. Schlich
MATHYS & SQUIRE

Exhibit A

Enc: Assignment, Declaration/Power of Attorney, stamped envelope

/bh



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Our Ref: GWS/MRM/19296
Yr. Ref: -

David Flynn Esq
7 Welland Close
Crowborough
East Sussex TN6 3BF

12 May 1999
BY REGISTERED MAIL

Dear David,

US Patent Application No. 09/236,113
"Reversing Field"
In the name of Shi, et al.

You will recall you are named as an inventor on a number of patent applications filed in the name of Nanyang Technological University. The application covering the "Reversing Field" invention has recently been filed as a patent application in the USA. Each of the inventors is initially named as applicant in the USA and are required as a matter of formality to execute (i) a Declaration and (ii) an Assignment in respect of the US patent application.

I am enclosing both documents and would be grateful if you could sign and date them where indicated.

Also enclosed is a stamped envelope for return of these forms and I look forward to receiving them from you. If you have any questions about the forms then I would ask you to call me on 0171 830 0000.

Lastly, we are currently required to file these forms in the USA before 12 May 1999 however, as discussed by telephone, a one month extension has been obtained and I would be most grateful if you would sign and return the forms within the next few days.

Yours sincerely

George W. Schlich
MATHYS & SQUIRE

Exhibit B

Enc: "Assignment" and "Declaration/Power of Attorney" forms
Stamped addressed envelope

/rs

S.D. RITTER M.A. (Cantab) M.Sc. (London)
P.D. GARRATT M.A. (Oxon)
M.C. MOIR B.Sc. (Eng) C.Eng. F.I.Mech.E. M.I.T.M.A.
P.D. COZENS M.A. (Cantab) Ph.D. (London) D.I.C.
G.W. SCHLICH M.A. (Cantab)
I. KAZI M.A. (Cantab)
S.G. COLMER B.A. (Cantab)



MATHYS & SQUIRE

*Chartered Patent Attorneys
European Patent Attorneys
Trade Mark Attorneys*

THIS FACSIMILE TRANSMISSION
OF 1 PAGE(S) TO NO: 00 65 792 1737
WILL NOT BE CONFIRMED BY MAIL.

100 GRAY'S INN ROAD LONDON WC1X 8AL
TELEPHONE +44 (0)171-830 0000
FACSIMILE +44 (0)171-830 0001
EMAIL mail@mathys-squire.com

Our Ref: GWS/MRM/19296
Yr. Ref: -

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OFFICE OF PETITIONS

Prof. Yeong Hin Yuen
Filplas Vacuum Technology PTE Ltd
c/o Innovation Centre
Block 1, Unit 3
Nanyang Avenue
Singapore 639798

14 May 1999

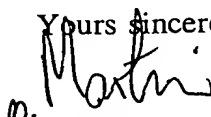
Dear Professor Yeong,

US Patent Application No. 09/236 113
"Cathode arc source and graphite target"
In The Name Of Shi, et al

Further to my letter of 12th May 1999, I have spoken with David Flynn. David advised that he is currently refusing to sign the "Assignment" and "Declaration/Power of Attorney" forms until he has confirmed his inventorship contribution with NTU and until potential inventorship recompense has been settled with NTU. In particular, David indicated that he was rather upset to be identified as the fourth inventor, when he considered that he was the primary inventor in connection with the above application.

David indicated that he hoped to clarify the above position within the next week so that he would then be in a position to sign the forms and return them to me. I shall keep you informed of further developments.

Yours sincerely,


George W Schlich
MATHYS & SQUIRE

PS. Prof. Yeong, I have reported the above situation in the absence of George who is currently on holiday. Should you wish to speak to George he will be back in the office on 20th May 1999.

MRM/KSS

Exhibit C

THIS MESSAGE IS CONFIDENTIAL AND MAY CONTAIN PRIVILEGED INFORMATION
INTENDED ONLY FOR THE USE OF THE ADDRESSEE

Associates: B.V. INGRAM M.J. ARNOTT M.I.T.M.A. E.A. SIMONS
Consultants: J.A.D. CROPP M.G. HARMAN P.L. KOLKER K.S. TARGETT

From: Shi Xu (Assoc Prof)
Sent: Wednesday, July 28, 1999 11:28 AM
To: 'George Schlich'
Cc: Tan Hong Siang (Prof); Yeong Hin Yuen (Assoc Prof); Tay Beng Kang (Assoc Prof)
Subject: David Flynn

Dear George,

Regarding to David's issue, we have assured him that no inventor has ever obtained any benefit arising from the patents so far except the very early payment by Avimo. We have also assured him that he will get his fair share if there is any benefit given to inventors.

We have total 9 patent applications filed so far related to the FCVA technology. David is involved in the previous three. He might seek your confirmation on this. All information made to the public can certainly provided to David.

It is therefore to David's own interest to proceed with the paper work. He understands that benefit due to the inventors, if there is any, will be given by NTU according to rules and regulations. It is up to the inventors to decide our own distribution. We have already proposed a fair solution to him and his response was positive.

Please contact David and ask him to finish the paper work. If he still refuses to sign we would have to take other actions as you suggested in your letter.

Best wishes,

Xu

Xu Shi, Ph.D.

Associate Professor

Block S2, School of EEE

Nanyang Technological University

SINGAPORE 639798

Tel: (65) 7905454 or 7906127. Fax: (65) 7912687, 7933318

Email: esxu@ntu.edu.sg

Exhibit D

Our Ref: GWS/MRM/19296
Yr. Ref: -

David Flynn Esq
7 Welland Close
Crowborough
East Sussex TN6 3BF

BY REGISTERED MAIL

4 August 1999

Dear David,

US Patent Application No. 09/236 113
"Cathode arc source and graphite target"
In the name of Shi, *et al.*

I understand from Professor Yeong Hin Yuen that you have recently been in contact with Nanyang Technological University to discuss recompense in respect of various patent applications (including the above) for which you are a named inventor. I hope that the discussions have concluded to your satisfaction.

You will recall that there are two outstanding forms on the above application for which your signature is required (enclosed). Assuming that you are now prepared to sign, would you please sign and date these forms and return them to me at your earliest possible convenience. If you are still not prepared to sign the forms would you please give me a call to confirm this.

Yours sincerely,

George W. Schlich
MATHYS & SQUIRE

Enc: "Assignment" and "Declaration/Power of Attorney" forms

/JJ

Exhibit E

Our Ref: GWS/19296
Yr. Ref: -

Mr. David Flynn
7 Welland Close
Crowborough
East Sussex
TN6 3BF

VIA REGISTERED POST

8 November 2000

Dear David

United States Patent Application No. 09/236 113
"Cathode arc source and graphite target"
Filplas Vacuum Technology PTE Ltd

You will be aware that a US patent application has been filed in respect of the invention entitled "Cathode arc source and graphite target". This US patent application has application number 09/236,113. You are named as an applicant/inventor in respect of this US application and accordingly we ask you to review the enclosed copy of the application as filed and review the enclosed declaration and assignment documents and ask you to sign and date the declaration where marked and sign and date the assignment where marked.

If you have any questions above these documents or your signatures or any other related matter I would be glad to deal with these questions and look forward to hearing from you.

We are currently under a deadline for filing these papers at the USPTO which expires on 3rd December 2000.

Accordingly, we would be grateful if you could sign and date the forms as described above and ensure these are returned to us by:-

Friday, 24 November 2000

Yours sincerely,

George W Schlich
MATHYS & SQUIRE

Enc: Application, Declaration & Assignment.

GWS/KSS/cm

Exhibit F